



FPW

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Hiroshi SUZUKI et al.

Group Art Unit: 1795

Application No.: 10/584,342

Examiner: A. ARCIERO

Filed: June 23, 2006

Docket No.: 128458

For: FUEL CELL DISASSEMBLY METHOD AND FUEL CELL

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the August 7, 2008, Restriction and Election of Species Requirements,
please consider the following remarks.

I. Restriction Requirement

In reply to the Restriction Requirement, Applicants provisionally elect Group 1,
claims 1-3, 5, and 8-14, with traverse.

Applicants respectfully submit that there exists *a priori* unity of invention at least with respect to elected claims 1-3, 5, and 8-14 and non-elected claims 15-22. Claims 15-22 have unity of invention with claims 1-3, 5, and 8-14 because all of the claims share a "special technical feature." Each of the claims specifies an electrode assembly having an electrolyte interposed between a pair of electrodes; sealing layers located to surround periphery of the electrode assembly; and a pair of separators arranged across the electrode assembly and bonded to the sealing layers, where one of the separators facing one of the electrodes has a

fuel gas conduit, while the other of the separators facing the other of the electrodes has an oxidizing gas conduit.

As stated in Annex B (Unity of Invention) of the Administrative Instructions Under the PLT, which is contained in the MPEP:

(b) Technical Relationship. . . . Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding "special technical features." The expression "special technical features" is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art.

Claims 1-3, 5, and 8-22 are linked so as to form a single general inventive concept under PCT Rule 13.2 because they each share a "special technical feature" as discussed above.

Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claims are known. *See* ISPE 10.07 and 10.08.

The Office Action does not establish that each and every element of the single general inventive concept of independent claims 1, 13-15, and 20 are known in the prior art. The Office Action asserts that Groups I and II do not relate to a single general inventive concept because Maruyama et al. (US 6,610,435) teaches the technical feature of a fuel cell comprising an electrode assembly, gaskets located on the periphery of the electrode assembly, and separators having a fuel supply conduit and the other an oxidizing supply conduit.

However, Maruyama discloses that the gasket is formed on the solid polymer electrolyte membrane marginal portion by injection molding (Maruyama, col. 4, lines 38-41). Nowhere does Maruyama disclose sealing layers located to surround periphery of the electrode assembly, as claimed. Maruyama further discloses that fuel gas supply conduits 11a

convey fuel gas between the separators 1A and 1B and the electrode unit 3 (Maruyama, col 4, lines 59-62). Maruyama also discloses that the air supply conduits 11b convey air between the separators 1B and 1C and the electrode unit 3 (Maruyama, col. 4, lines 62-65). However, nowhere does Maruyama disclose that one of the separators facing one of the electrodes has a fuel gas conduit, while the other of the separators facing the other of the electrodes has an oxidizing gas conduit, as claimed. Therefore, Applicants respectfully submit that lack of unity of invention has not been established, and thus a Restriction Requirement at this time is improper.

In addition, on February 6, 2008, a first Office Action was issued on the merits addressing all of the pending claims. Applicants timely filed a response to this Office Action on April 22, 2008. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden, at least because the full scope of the claims has already once been searched and examined on the merits. Because Applicants have elected Group I, directed to the disassembly of a specific fuel cell, the further search and examination of Group II, directed to the specific fuel cell of claim 1 of Group I, would not place a serious burden upon the Examiner.

For at least these reasons, the issuance of this Restriction Requirement has prejudiced Applicants by causing unnecessary delay and expense to Applicants and duplicative examination by the Patent Office. It is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

II. Election of Species Requirement

In reply to the Election of Species Requirement, Applicants provisionally elect species A, with traverse. At least claims 1-3, 5, and 8-12 read on the elected species. At the present time, no claims are believed to be generic.

However, this Election of Species Requirement is strongly traversed since it is contrary to PCT rules. For example, PCT Rule 13 requires that claims which encompass one single general inventive concept be searched and examined in the same international application. In addition, PCT Rule 13.1 states: "the international application shall relate to one invention or to a group of inventions so linked as to form a single general inventive concept."

Furthermore, PCT Rule 13.4 expressly states that: "subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention."

The Election of Species Requirement is a convention specific to U.S. National Patent Application Examination practice. PCT Rule 13.1 specifically contemplates the single examination of a group of inventions so linked as to form a single general inventive concept, and PCT Rule 13.4 specifically requires examination of species claims within a single general inventive concept. Nothing in the PCT or its rules permits issuing an Election of Species Requirement. Election of species practice is not provided for under PCT Rules 13.1-13.4 and is contrary to PCT national phase application practice.

The Examiner is respectfully requested to reconsider and withdraw the Election of Species Requirement and to examine all of the species and claims in this application.

Early and favorable consideration of the application is requested.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Joel S. Armstrong
Registration No. 36,430

JAO:JLR/amw

Date: September 8, 2008

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
